

Appl. No. 10/071,537
Response dated September 13, 2007
Reply to Office Action of July 17, 2007

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REMARKS/ARGUMENTS

The Applicant requests reconsideration of the application in view of the following remarks:

The References And Differences Of The Present Invention Thereover

Prior to discussing the claims and the above seven points, applicant will first discuss the references and the general novelty of the present invention and its unobviousness over the references.

The last O.A. describes the Deaton system as having the following attributes:

1. Delivers shopping incentives individually customized to influence each customer in which the incentives are generated by a plurality of independently competing manufacturer controlled dynamic offer engines that customize each incentive to meet manufacturer objectives including market share.
2. Determines the incentives based on current purchases (scanned at point of sale) and customer past history.
3. Deaton does not specify a wireless scanning device.

Deaton creates incentives for customers but it describes a system that requires tight integration with traditional store point of sale (POS) systems to capture data as products are being purchased via the POS system's integrated scanner. It is only at the moment of purchase that that all data captured is relayed to the manufacturer in near real time. The only data that could be construed as customer behavior information used in this process is based on products actually purchased. Deaton does not describe using consumer motivation metrics that can be derived from comparing the product selected while shopping, tracking the incentives offered and ultimately observing the incentives rejected and the products purchased. Consumer incentives in the Deaton system fall into two categories; post-purchase targeted incentives which are delivered via POS register coupons or via internet email, and pre-purchase incentives which are delivered via an in

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store kiosk. The kiosk incentives are not dynamic as they do not require the communication of data with the retailers at that moment but instead rely on past purchase information and stored incentives with no regard given to what incentives may best motivate this particular customer given past dynamic negotiations. Further POS integration describes product price changes can be initiated remotely by the manufacturer and immediately made effective in the retail store. This integration includes pushing the price into the retailer's POS system and electronic price tags to display the new price installed throughout each store. The UPC server described in Deaton may generate incentives on behalf of the manufacturer, vendor, store, or wholesaler which reasonably shows that the incentives are not always rendered from a distributed dynamic system that allows manufacturers complete control over the incentives delivered.

The last O.A. describes the Sloane system as having the following attributes:

1. Sloane teaches a wireless device with a UPC barcode scanner used by the shopper to scan product bar codes in a store.
2. The device uses the bar codes scanned, along with consumer purchase history (shopper information) to determine an incentive for the user.
3. The incentive offered to the user could be a promotion for the product scanned or a promotion for other competitive products (an example of a competitive incentive offer engine)
4. The user selects which promotional offers to be redeemed
5. The wireless device can communicate the redeemed incentives to a point of sale.

Sloane creates incentives for a customer however none of the incentives provided are dynamic or customized for the customer. Sloan also fails to teach competing incentive engines to provide such incentives. Sloan instead uses simple shopping history only to see if a customer qualifies for other predetermined promotions or frequent shopper program but falls far short of attempting to quantify a shoppers motivation by comparing history of first scanned items by category or by accounting for a history of coupons (and values) offered versus the coupons actually redeemed (acceptance/rejection patterns to

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determine brand loyalty/price sensitivity). Furthermore, Sloan describes a system that is designed to replace the traditional point of sale (POS) system in most stores by providing customer self checkout functionality and further reinforcing this intention by including integrated video surveillance in the device to deter shoplifting.

The last O.A. describes the Antilla system as having the following attributes:

1. Antilla teaches a wireless device that generates a scannable bar code.

Antilla creates incentives for a customer however it does not describe providing dynamic or customized coupons. The system in Antilla uses a Master/Copy model for sharing static valued coupons. The value of a given coupon may change but the value is varied based on a formula related to the sharing of a coupon but the value is not changed because of a shopping behavior heuristics. Furthermore, coupon values are static and are not determined or varied in real time.

The Rejection Of Claim 1 On Deaton In View Of Sloane Is Overcome

The last O.A. rejected Claim 1 on the teachings of Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211). Applicant requests reconsideration and allowance over this rejection for the following reasons:

1. There is no suggestion to combine these references.
2. The references take mutually exclusive paths and reach different solutions to a similar problem therefore, by implication, each teaches away from combining itself with the other. Since they teach away from each other it would not be logical to combine them.
3. The references themselves teach away by implication from the suggested combination.
4. Even if Deaton and Sloane were to be combined in the manner proposed, the proposed combination would not show all of the novel features of claim 1.
5. The novel features of claim 1 produce new and unexpected results and hence are unobvious and patentable over these references.

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6. It would not have been obvious to one having ordinary skill in the art to combine Deaton and Sloane.

There Is No Suggestion To Combine These References

With regard to the proposed combination of Deaton and Sloane, the suggestion to combine the references should not come from applicant was forcefully stated in *Orthopedic Equipment Co. v. United States*, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983):

"It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here the PTO]."

As was further stated in *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988), "[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself"

In line with these decisions, the Board stated in *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (P.T.O.B.A.&I. 1993):

"In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present *evidence*, preferably in the form of some teaching, suggestion, incentive or inference in the plied prior-art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention... That which is within the capabilities of one skilled in the art is not synonymous with obviousness... That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of

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logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention...Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that 'would lead' that individual 'to combine the relevant teachings of the references'...Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done."

In the present case, there is no reason given in the last O.A. to support the proposed combination. However, the fact that both references teach a system for providing a discount offer is not sufficient to gratuitously and selectively substitute parts of one reference (Deaton's independently competing manufacturer controlled dynamic offer engines) for a part of another reference in order to meet applicant's novel claimed combination.

References Take Mutually Exclusive Paths And Reach Different Solutions To A Similar Problem Therefore, By Implication, Each Teaches Away From Combining Itself With The Other. Since They Teach Away From Each Other It Would Not Be Logical To Combine Them.

The common objective of offering an incentive to a customer falls short of providing justification to combine the references. Furthermore, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

Reference directly teaches away from combination. As indicated in the O.A., "Deaton determines incentives based on current purchases (scanned at point of sale)". Sloane

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however describes a system that is used to scan products while still shopping, specifically identified as "Point-of-Purchase" whereby products are only selected and their ultimate purchase remains in question and open to influence. Sloane even discusses the distinction between the term point-of-sale as used by Deaton.

"Promotional offers and coupon distribution for competitive products serve to alter the consumer's future purchasing behavior. The most widely used example of this involves coupons printed and distributed at the supermarket or retailer checkout counter based on the items that are purchased (i.e., point-of-sale). These issued coupons must be used on a subsequent trip to the supermarket or retail establishment." (Column 1, Lines 44-50)

As described in Sloane products would not be purchased until the consumer returns the portable bar code scanner to the scanner center. Since the scanner would now be returned and no longer in the possession of the consumer all incentives would again have to be delivered after the shopping is completed as described in Deaton. Sloane goes on to further teach away from integrating with a system similar to Deaton by commenting on the inferiority of such a design.

"U.S. Pat. Nos. 4,910,672, 4,723,212, and 5,173,851, assigned to Catalina Marketing Corporation, disclose methods of dispensing coupons, including coupons for competitive products, based on a consumer's purchases as they are identified by the bar code scanner mounted inside the checkout counter, and connected to point-of-sale electronic system. Each of the systems disclosed require the use of checkout counter scanners, which are used as point-of-sale devices.

The prior art methods of distributing consumer promotions and coupons, based on checkout scanner information, in an effort to affect future purchasing behavior are inefficient. This inefficiency is due to the fact that a substantial number of the

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issued discounts or coupons go unused because consumers are required to remember to bring them to the store on their next visit." (Column 1, Lines 51-67)

It would be illogical to combine Sloane and Deaton given Sloane's explicit teaching away from systems as described in Deaton.

References each capture information about a customer's purchase at distinctly different moments in the shopping process. While Sloane allows for the capture of product UPC codes during the product selection phase, Deaton instead captures product information at the final moment when a purchase is being made. Given the discrepancies in when data is captured these references teach away from each other by implication.

References have completely different time frames for providing customer purchase information to the manufacturer. Sloan describes a system that provides static incentives to a customer based upon searching through a preloaded non-dynamic collection of incentives on a remote server or database. As such, any information a manufacturer will capture about the shopper is received long after the shopping and ultimate purchase has taken place. Deaton describes a system that provides product purchase information to the manufacturer at the moment the purchase is being completed. Given the discrepancies in the systems for capturing data and when said data is provided to the manufacturers these references teach away from each other by implication.

References have completely different systems for determining the incentives that should be offered to a customer. Sloane teaches a system where incentives are selected from among those that have been preloaded into a server or database. Deaton describes a system that delivers shopping incentives which are generated by a plurality of independently competing manufacturer controlled dynamic offer engines that customize each incentive to meet manufacturer objectives. Given the discrepancies in the systems for determining the incentives to offer these references teach away from each other by implication.

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References have completely different means of delivering incentives to customers. Sloane teaches displaying incentives directly on a wireless device in the store while shopping. Deaton teaches a system that offers custom incentives printed at the register after the purchase is complete, delivered via email some time after the shopping is done, or alternatively printed at a kiosk in the store during the next shopping visit. Given the discrepancies in the systems for delivering incentives these references teach away from each other by implication.

References have dramatically different descriptions regarding integration with traditional Point of Sale systems. Deaton teaches a system that is very tightly integrated with the traditional existing store POS system with a cash register and scanner at the end of a check out isle. As the Deaton system depends on data collected at the point of purchase and not during the shopping process it depends on this configuration. Sloane, on the other hand, describes a system that is designed to replace the traditional POS system seen today and instead teaches a system with consumer self directed checkout that maintains a running total of purchases as a customer shops throughout the store. Given the discrepancies in utilization of traditional POS systems versus cart focused consumer directed checkout these references teach away from each other by implication.

Since the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified the teachings of the references are not sufficient to render the claims prima facie obvious.

Even If Deaton And Sloane Were To Be Combined In The Manner Proposed, The Proposed Combination Would Not Show All Of The Novel Features Of Claim 1.

Even if the combination of Deaton and Sloane were legally justified, claim 1 would still have novel (and unobvious) features over the proposed combination. In other words applicant's invention as defined by Claim 1 comprises much more than starting with Deaton and adding the wireless scanning device as described in Sloane. Those features

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including a system for delivering shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

These Novel Features Of Claim 1 Produce New And Unexpected Results And Hence Are Unobvious And Patentable Over These References.

Also applicant submits that the novel features of claim 1 are also unobvious and hence patentable under § 103 since they produce new and unexpected results over Sloane and Deaton.

The new and unexpected results is a system for delivering shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

It Would Not Have Been Obvious To One Having Ordinary Skill In The Art To Combine Deaton And Sloane.

The novel features of claim 1 produce new and unexpected results and hence are unobvious and patentable over these references. It would not have been obvious to one having ordinary skill in the art to combine Deaton and Sloane.

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The Rejection Of Claim 9 On Deaton In View Of Sloane Is Overcome

The last O.A. rejected Claim 9 on the teachings of Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211). Applicant requests reconsideration and allowance over this rejection for the following reasons:

1. There is no suggestion to combine these references.
2. The references take mutually exclusive paths and reach different solutions to a similar problem therefore, by implication, each teaches away from combining itself with the other. Since they teach away from each other it would not be logical to combine them.
3. The references themselves teach away by implication from the suggested combination.
4. Even if Deaton and Sloane were to be combined in the manner proposed, the proposed combination would not show all of the novel features of claim 9.
5. The novel features of claim 9 produce new and unexpected results and hence are unobvious and patentable over these references.
6. It would not have been obvious to one having ordinary skill in the art to combine Deaton and Sloane.

There Is No Suggestion To Combine These References

As noted above, there is ample case law that discusses impermissible hindsight vision afforded by the claimed invention.

In the present case, there is no reason given in the last O.A. to support the proposed combination. However, the fact that both references teach a method for providing a discount offer is not sufficient to gratuitously and selectively substitute parts of one reference (Deaton's independently competing manufacturer controlled dynamic offer engines) for a part of another reference in order to meet applicant's novel claimed combination.

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References Take Mutually Exclusive Paths And Reach Different Solutions To A Similar Problem Therefore, By Implication, Each Teaches Away From Combining Itself With The Other. Since They Teach Away From Each Other It Would Not Be Logical To Combine Them.

The common objective of offering an incentive to a customer falls short of providing justification to combine the references. Furthermore, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

Reference directly teaches away from combination. As indicated in the O.A., "Deaton determines incentives based on current purchases (scanned at point of sale)". Sloane however describes scanning products while still shopping, a moment specifically identified as "Point-of-Purchase" whereby products are only selected and their ultimate purchase remains in question and open to influence. Sloane even discusses the distinction between the term point-of-sale as used by Deaton.

"Promotional offers and coupon distribution for competitive products serve to alter the consumer's future purchasing behavior. The most widely used example of this involves coupons printed and distributed at the supermarket or retailer checkout counter based on the items that are purchased (i.e., point-of-sale). These issued coupons must be used on a subsequent trip to the supermarket or retail establishment." (Column 1, Lines 44-50)

As described in Sloane products would not be purchased until the consumer returns the portable bar code scanner to the scanner center. Since the scanner would now be returned and no longer in the possession of the consumer all incentives would again have to be delivered after the shopping is completed as described in Deaton. Sloane goes on to further teach away from integrating with anything similar to Deaton by commenting on the inferiority of such a design.

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"U.S. Pat. Nos. 4,910,672, 4,723,212, and 5,173,851, assigned to Catalina Marketing Corporation, disclose methods of dispensing coupons, including coupons for competitive products, based on a consumer's purchases as they are identified by the bar code scanner mounted inside the checkout counter, and connected to point-of-sale electronic system. Each of the systems disclosed require the use of checkout counter scanners, which are used as point-of-sale devices.

The prior art methods of distributing consumer promotions and coupons, based on checkout scanner information, in an effort to affect future purchasing behavior are inefficient. This inefficiency is due to the fact that a substantial number of the issued discounts or coupons go unused because consumers are required to remember to bring them to the store on their next visit." (Column 1, Lines 51-67)

It would be illogical to combine Sloane and Deaton given Sloane's explicit teaching away from systems as described in Deaton.

References each capture information about a customer's purchase at distinctly different moments in the shopping process. While Sloane allows for the capture of product UPC codes during the product selection phase, Deaton instead captures product information at the final moment when a purchase is being made. Given the discrepancies in when data is captured these references teach away from each other by implication.

References have completely different methods and time frames for providing customer purchase information to the manufacturer. Sloan describes a method for providing static incentives to a customer based upon searching through a preloaded non-dynamic collection of incentives on a remote server or database. As such, any information a manufacturer will capture about the shopper is received long after the shopping and ultimate purchase has taken place. Deaton describes a method for providing product purchase information to the manufacturer at the moment the purchase is being completed.

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Given the discrepancies in method of capturing data and when said data is provided to the manufacturers these references teach away from each other by implication.

References have completely different methods of determining the incentives that should be offered to a customer. Sloane teaches a method where incentives are selected from among those that have been preloaded into a server or database. Deaton describes a method that delivers shopping incentives which are generated by a plurality of independently competing manufacturer controlled dynamic offer engines that customize each incentive to meet manufacturer objectives. Given the discrepancies in method of determining the incentives to offer these references teach away from each other by implication.

References have completely different means of delivering incentives to customers. Sloane teaches displaying incentives directly on a wireless device in the store while shopping. Deaton teaches a method that offers custom incentives printed at the register after the purchase is complete, delivered via email some time after the shopping is done, or alternatively printed at a kiosk in the store during the next shopping visit. Given the discrepancies in method of delivering incentives these references teach away from each other by implication.

References have dramatically different descriptions regarding integration with traditional Point of Sale systems. Deaton teaches a method that tightly integrates with the traditional existing store POS system with a cash register and scanner at the end of a check out isle. As the method described by Deaton depends on data collected at the point of purchase and not during the shopping process it depends on this configuration. Sloane, on the other hand, describes a method that is designed to replace the traditional POS system seen today and instead teaches a method for consumer self directed checkout that maintains a running total of purchases as a customer shops throughout the store. Given the discrepancies in utilization of traditional POS systems versus cart focused consumer directed checkout these references teach away from each other by implication.

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Since the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified the teachings of the references are not sufficient to render the claims prima facie obvious.

Even If Deaton And Sloane Were To Be Combined In The Manner Proposed, The Proposed Combination Would Not Show All Of The Novel Features Of Claim 9.

Even if the combination of Deaton and Sloane were legally justified, claim 9 would still have novel (and unobvious) features over the proposed combination. In other words applicant's invention as defined by Claim 9 comprises much more than starting with Deaton and adding the wireless scanning device as described in Sloane. Those features including a method for delivering shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

These Novel Features Of Claim 9 Produce New And Unexpected Results And Hence Are Unobvious And Patentable Over These References.

Also applicant submits that the novel features of Claim 9 are also unobvious and hence patentable under § 103 since they produce new and unexpected results over Sloane and Deaton.

The new and unexpected results is a method for delivering shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet

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the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

It Would Not Have Been Obvious To One Having Ordinary Skill In The Art To Combine Deaton And Sloane.

The novel features of claim 9 produce new and unexpected results and hence are unobvious and patentable over these references. It would not have been obvious to one having ordinary skill in the art to combine Deaton and Sloane.

Dependent Claims 2-5, 7, And 8 Are A Fortiori Patentable Over Deaton In View Of Sloane

The last O.A. rejected dependent Claims 2-5, 7, and 8 on the teachings of Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211). Original dependent claims 2-5, 7, and 8 incorporate all the subject matter of Claim 1 and add additional subject matter, which makes them a fortiori and independently patentable over this reference.

Dependent Claims 10-13, 15 And 16 Are A Fortiori Patentable Over Deaton In View Of Sloane

The last O.A. rejected dependent Claims 10-13, 15 and 16 on the teachings of Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211). Original dependent claims 10-13, 15 and 16 incorporate all the subject matter of Claim 9 and add additional subject matter, which makes them a fortiori and independently patentable over this reference.

The Rejection Of Dependent Claim 6 In View Of Deaton In View Of Sloane And Further In View Of Anttilla Is Overcome

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The last O.A. rejected dependent Claim 6 on the combined teachings of Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211) and further in view of Anttilla (U.S. Patent No. 6,862,575). Applicant requests reconsideration and allowance over this rejection for the following reasons:

1. There is no suggestion to combine these references.
2. The references take mutually exclusive paths and reach different solutions to a similar problem therefore, by implication, each teaches away from combining itself with the other. Since they teach away from each other it would not be logical to combine them.
3. The references themselves teach away by implication from the suggested combination.
4. Even if the references were to be combined in the manner proposed, the proposed combination would not show all of the novel features of claim 6.
5. It would not have been obvious to one having ordinary skill in the art to combine Deaton, Sloane and Anttilla.

Applicant submits that as Claim 1 already overcomes Deaton and Sloane the addition of a wireless device as generating a bar code to be scanned by a point of sale, as suggested by Anttilla, brings forth the same arguments made above against combining references.

There Is No Suggestion To Combine These References

As noted above, there is ample case law that discusses impermissible hindsight vision afforded by the claimed invention.

In the present case, there is no reason given in the last O.A. to support the proposed combination. The original dependent claim 6 incorporates all the subject matter of claim 1 and adds additional subject matter. Applicant submits that since claim 1 overcomes Deaton and Sloane claim 6 is already a fortiori and independently patentable over Deaton in view of Sloane regardless of Anttilla. That all noted references teach a system for providing a discount offer is not sufficient to gratuitously and selectively substitute parts

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of one reference for parts of other references in order to meet applicant's novel claimed combination, as exemplified by adding Deaton's independently competing manufacturer controlled dynamic offer engines and Antilla's scannable bar code display.

References Take Mutually Exclusive Paths And Reach Different Solutions To A Similar Problem Therefore, By Implication, Each Teaches Away From Combining Itself With The Other. Since They Teach Away From Each Other It Would Not Be Logical To Combine Them.

The common objective of offering an incentive to a customer falls short of providing justification to combine the references. Furthermore, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

Sloane and Deaton already teach strongly away from each other (as noted above). The addition of another feature from Antilla does not overcome the teaching away of Sloane and Deaton and, furthermore, fails to add any value to the combination even if it were permitted. The integration of Deaton and Sloane, as suggested by the O.A., would eliminate the traditional POS system as described in Deaton and instead would create a system with an integrated hand held wireless customer self actuated POS system. It would be illogical to add a scannable barcode display to the wireless device of this resultant system since there would be no traditional POS system to scan the barcodes on said display. This lack of logical combination additionally teaches away from such a combination.

Since the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified the teachings of the references are not sufficient to render the claims prima facie obvious.

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Even If Deaton, Sloane, And Anttilla Were To Be Combined In The Manner Proposed, The Proposed Combination Would Not Show All Of The Novel Features Of Claim 6.

Even if the combination of Deaton, Sloane, and Anttilla were legally justified, claim 6 incorporating all the subject matter of Claim 1 would still have novel (and unobvious) features over the proposed combination. In other words applicant's invention as defined by Claim 6 comprises much more than starting with Deaton and adding the wireless scanning device as described in Sloane and then adding a scannable bar code display.

The new and unexpected results is a system that integrates seamlessly with traditional POS systems that delivers shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

These Novel Features Of Claim 6 Produce New And Unexpected Results And Hence Are Unobvious And Patentable Over These References.

Also applicant submits that the novel features of claim 6 incorporating all the subject matter of claim 1 are also unobvious and hence patentable under § 103 since they produce new and unexpected results over Sloane, Deaton, and Anttilla.

The new and unexpected results is a system that integrates seamlessly with traditional POS systems that delivers shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal

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concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

It Would Not Have Been Obvious To One Having Ordinary Skill In The Art To Combine Deaton, Sloane, And Anttilla.

The novel features of claim 6 incorporate all the subject matter of claim 1 produce new and unexpected results and hence are unobvious and patentable over these references. It would not have been obvious to one having ordinary skill in the art to combine Deaton, Sloane, and Anttilla.

The Rejection Of Dependent Claim 14 In View Of Deaton In View Of Sloane And Further In View Of Anttilla Is Overcome

The last O.A. rejected dependent claim 14 on the combined teachings of Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211) and further in view of Anttilla (U.S. Patent No. 6,862,575). Applicant requests reconsideration and allowance over this rejection for the following reasons:

1. There is no suggestion to combine these references.
2. The references take mutually exclusive paths and reach different solutions to a similar problem therefore, by implication, each teaches away from combining itself with the other. Since they teach away from each other it would not be logical to combine them.
3. The references themselves teach away by implication from the suggested combination.
4. Even if the references were to be combined in the manner proposed, the proposed combination would not show all of the novel features of claim 14.
5. It would not have been obvious to one having ordinary skill in the art to combine Deaton, Sloane and Anttilla.

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Applicant submits that as claim 9 already overcomes Deaton and Sloane the addition of a wireless device as generating a bar code to be scanned by a point of sale, as suggested by Anttilla, brings forth the same arguments made above against combining references.

There Is No Suggestion To Combine These References

As noted above, there is ample case law that discusses impermissible hindsight vision afforded by the claimed invention.

In the present case, there is no reason given in the last O.A. to support the proposed combination. The original dependent claim 14 incorporates all the subject matter of claim 9 and adds additional subject matter. Applicant submits that since claim 9 overcomes Deaton and Sloane claim 14 is already a fortiori and independently patentable over Deaton in view of Sloane regardless of Anttilla. That all noted references teach a method of providing a discount offer is not sufficient to gratuitously and selectively substitute parts of one reference for parts of other references in order to meet applicant's novel claimed combination, as exemplified by adding Deaton's independently competing manufacturer controlled dynamic offer engines and Anttilla's scannable bar code display.

References Take Mutually Exclusive Paths And Reach Different Solutions To A Similar Problem Therefore, By Implication, Each Teaches Away From Combining Itself With The Other. Since They Teach Away From Each Other It Would Not Be Logical To Combine Them.

The common objective of offering an incentive to a customer falls short of providing justification to combine the references. Furthermore, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

Sloane and Deaton already teach strongly away from each other (as noted above). The addition of another feature from Anttilla does not overcome the teaching away of Sloane and Deaton and, furthermore, fails to add any value to the combination even if it were permitted. The integration of Deaton and Sloane, as suggested by the O.A., would

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eliminate the traditional POS system as described in Deaton and instead would create a method using an integrated hand held wireless customer self actuated POS system. It would be illogical to add a scannable barcode display to the wireless device of this type since there would be no traditional POS system to scan the barcodes on said display. This lack of logical combination additionally teaches away from such a combination.

Since the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified the teachings of the references are not sufficient to render the claims prima facie obvious.

Even If Deaton, Sloane, And Anttilla Were To Be Combined In The Manner Proposed, The Proposed Combination Would Not Show All Of The Novel Features Of Claim 14.

Even if the combination of Deaton, Sloane, and Anttilla were legally justified, claim 14 incorporating all the subject matter of claim 9 would still have novel (and unobvious) features over the proposed combination. In other words applicant's invention as defined by Claim 14 comprises much more than starting with Deaton and adding the wireless scanning device as described in Sloane and then adding a scannable bar code display.

The new and unexpected result is a method for delivering shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made, whereby said incentives are further seamlessly redeemable by traditional POS systems.

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These Novel Features Of Claim 14 Produce New And Unexpected Results And Hence Are Unobvious And Patentable Over These References.

Also applicant submits that the novel features of claim 14 incorporating all the subject matter of claim 9 are also unobvious and hence patentable under § 103 since they produce new and unexpected results over Sloane, Deaton, and Anttilla.

The new and unexpected result is a method for delivering shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made, whereby said incentives are further seamlessly redeemable by traditional POS systems.

It Would Not Have Been Obvious To One Having Ordinary Skill In The Art To Combine Deaton, Sloane, And Anttilla.

The novel features of claim 14 incorporate all the subject matter of claim 9 produce new and unexpected results and hence are unobvious and patentable over these references. It would not have been obvious to one having ordinary skill in the art to combine Deaton, Sloane, and Anttilla.

Non-Applied References

Regarding U.S. Patent No. 6,327,570 to Stevens, U.S. Patent No. 6,434,530 to Sloane, U.S. Patent No. 6,314,406 to O'Hagan, and U.S. Patent No. 5,250,789 to Johnsen, I have reviewed these patents and found that they do not show the current patent and fail to render it obvious.

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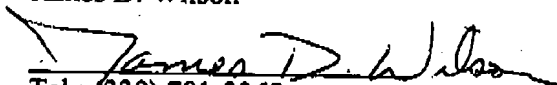
Conclusion

In view of the above it is submitted that the claims are in condition for allowance.
Reconsideration and allowance of the objections is respectfully requested.

Conditional Request For Constructive Assistance

Applicant has amended the claims of this specification so that they are proper, definite, and define a novel system and method, which is also unobvious. If for any reason this application is not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,
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